

White v. Samsung Electronics America, Inc.: **The Right of Publicity Spins Its Wheels**

PATRICIA B. FRANK*

I. INTRODUCTION

Since the 1950s, American law has recognized a property right in a person's publicity as "the right of each person to control and profit from the publicity values which he has created."¹ The idea was initially attractive; protecting a right of publicity would prevent a person from using another's name, image, or attributes without permission, thereby encouraging creativity. This right of publicity gave tangible value to people's efforts in creating their status by making them the sole agents of their promotion.² A tort resulted whenever the name, identity, or performance of a person was appropriated without authorization.³ From these modest beginnings, the right of publicity expanded as the need arose to protect different manifestations of publicity promotion.⁴ However, as evidenced by the Ninth Circuit's decision in *White v. Samsung Electronics America, Inc.*,⁵ the courts have widened the scope of the right of publicity to the point where serious efforts must be made to limit the encroachment of this personal property right upon First Amendment rights of free expression.⁶

Part II of this Note will discuss the evolution of the right of publicity and Part III will analyze the impact of the *White* opinion. Part IV will compare the treatment of First Amendment defenses in right of publicity cases with the treatment of such defenses in copyright cases. Analysis of the right of publicity is quite similar to that of copyright. Traditionally, the

* Winner of the 1994 Nathan Burkan Memorial Competition at The Ohio State University College of Law, sponsored by The American Society of Composers, Authors and Publishers.

¹ Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 216 (1954).

² See *id.* at 204, 216-19.

³ Common torts in this area include fraudulent endorsements and commercial exploitation by posters, memorabilia, and the like.

⁴ See *infra* text accompanying notes 40-58 for a discussion of the most crucial developments in the right of publicity's continuing evolution.

⁵ 971 F.2d 1395 (9th Cir.), *reh'g denied*, 989 F.2d 1512 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 2443 (1993).

⁶ "Congress shall make no law . . . abridging the freedom of speech, or of the press." U.S. CONST. amend. I.

courts have construed the right of publicity as an analogue to copyright and patent protection,⁷ particularly in terms of the interests a state seeks to protect. Part V examines how best to limit the right of publicity's impact on First Amendment rights, as well as the analogous situation in copyright law. Finally, this Note proposes the integration of copyright's idea/expression doctrine and fair use test into the right of publicity analysis. This author believes this integration to be a workable solution that both respects a person's right of publicity and ensures First Amendment freedoms.

II. THE RIGHT OF PUBLICITY: THE HISTORICAL BACKDROP

A. *Evolution of the Right of Publicity Out of the Right to Privacy*

The evolution of the right of publicity began in the articulation of a right to privacy which was defined as a "right to be let alone."⁸ This right centered on the disclosure of private facts; one waived protection once personal facts were made public.⁹ In particular, because this right centered on abridgment of the "right to be let alone," a celebrity of the era waived her right once she became the focus of media coverage. This waiver also served as a defense in privacy litigation.¹⁰ In the words of Samuel D. Warren and Louis D. Brandeis: "[t]here are [those] who, in varying

⁷ "[T]he State's interest [in establishing a right of publicity] is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors" *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 573 (1977).

⁸ Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 193 (1890). In the context of analyzing the progressive protection of a person's rights by legal codification, these authors reached the conclusion that existing libel and slander laws provided insufficient protection for personal privacy. *See id.* at 197-98, 213-19. The authors of this early work concentrated on the harm possible when one's privacy is invaded via disclosure of private matters. *See id.* at 214, 216-20. For a critique of their work, see William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 383-84, 389 (1960), and contrast with Harry Kalven, Jr., *Privacy in Tort Law: Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326 (1966) (criticizing the development of a right of privacy).

⁹ "The right to privacy ceases upon the publication of the facts by the individual, or with his consent." Warren & Brandeis, *supra* note 8, at 218.

¹⁰ *See id.* at 214-15, 218.

degrees, have renounced the right to live their lives screened from public observation."¹¹

In early nineteenth century America, poised as it was on the verge of the motion picture and television industries, celebrity status was not a particularly marketable commodity.¹² Therefore, a legal theory centering on personal dignity was a reasonable response to the concerns of the day. Later, when the economic value of celebrity status increased exponentially, those seeking to maximize the exploitation of their stardom needed a new theory to supply protection. Such a theory needed to be centered on the economic value of one's personality, especially in light of the above waiver defense of public disclosure.¹³

In response to evolving publicity needs, Melville Nimmer observed that the right of privacy "is not adequate to meet the demands of the second half of the twentieth century,"¹⁴ as it would provide little protection to popular figures in the burgeoning entertainment industry.¹⁵ Nimmer argued for the creation of a separate property theory. To this end, he articulated the tenets of the right of publicity as the "right of each person to control and profit from the publicity values which he has created or

¹¹ *Id.* at 215. American tort law accepted the innovation of a right to privacy, and ultimately commentators delineated four torts in the area: "[i]ntrusion upon the plaintiff's seclusion or solitude, or into his private affairs[;] [p]ublic disclosure of embarrassing private facts about the plaintiff[;] [p]ublicity which places the plaintiff in a false light in the public eye[;] [a]ppropriation, for the defendant's advantage, of the plaintiff's name or likeness." Prosser, *supra* note 8, at 389; *see also* W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS § 117 (5TH ED. 1984).

¹² *See* Nimmer, *supra* note 1, at 203-04.

¹³ As Melville Nimmer observed: "[w]ith the tremendous strides in communications, advertising, and entertainment techniques, the public personality has found that the use of his name, photograph, and likeness has taken on a pecuniary value undreamed of at the turn of the century." *Id.* at 204. For detailed histories of the right of publicity, *see generally* Lee Goldman, *Elvis is Alive, But He Shouldn't Be: The Right of Publicity Revisited*, 1992 B.Y.U. L. REV. 597 (arguing for the abolishment of the right of publicity) and Sheldon W. Halpern, *The Right of Publicity: Commercial Exploitation of the Associative Value of Personality*, 39 VAND. L. REV. 1199, 1200-15 (1986).

¹⁴ Nimmer, *supra* note 1, at 203.

¹⁵ Responding to the impact of the waiver defense, Nimmer employed the logic of the right of privacy and suggested that by entering the public eye, a person may waive her privacy in regard to professional life, but she does not automatically waive her right of privacy in her private life. *Id.* at 204-05. Nimmer further argued that even if modified, the waiver defense posed too great an obstacle to the genuine protection of property rights and turned to the articulation of the right of publicity. *Id.* at 206.

purchased.”¹⁶ Placing great faith in the courts to develop definite limits to this right, Nimmer suggested that, at a minimum, there should be a First Amendment “newsworthiness” exception, where the personal right of publicity would give way to the greater public interest of information dissemination.¹⁷ As originally formulated, the right of publicity was a narrow right—granted to fill the interstices of the right of privacy—and was subordinate to First Amendment guarantees of free press and free speech.

B. Courtroom Efforts: *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*

Just prior to Nimmer’s formative piece, the Second Circuit made the first foray into enforcing a common law right of publicity. In *Haelan Laboratories*,¹⁸ the court enjoined an unauthorized use of players’ pictures on baseball cards. The court portrayed the right of publicity as an extension of the right of privacy, designed to protect one’s economic interests in public exposure.¹⁹ Based on the players’ right of publicity—a right separate from, and in addition to, their right to privacy—the court acknowledged that “a man has a right in the publicity value—of his photograph,”²⁰ and it held that equitable relief was justified when this property right was infringed. Firmly connecting its decision to the

¹⁶ *Id.* at 216. Scholars’ writings on the right of publicity acknowledge that Nimmer’s article provides the foundation for the right of publicity. See Theodore F. Haas, *Storehouse of Starlight: The First Amendment Privilege to Use Names and Likenesses in Commercial Advertising*, 19 U.C. DAVIS L. REV. 539, 543 n.18 (1986).

¹⁷ See Nimmer, *supra* note 1, at 216–17.

¹⁸ *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953). In this case, the plaintiff was a contracting party with baseball players for the exclusive right to use their pictures on bubble gum cards. *Haelan Labs.*, 202 F.2d at 867. Allegedly, Topps “with knowledge of plaintiff’s exclusive rights,” used pictures of the contracting players on its cards, without the consent of the players. *Id.* at 868 (quoting plaintiff’s complaint). The defendant contended that “a man has no legal interest in the publication of his picture other than his right of privacy,” the idea being that since the players were public figures, they had waived their privacy rights. *Id.*

¹⁹ “[F]ar from having their feelings bruised through public exposure of their likenesses, [persons] would feel sorely deprived if they no longer received money for authorizing advertisements” *Id.* at 868.

²⁰ *Id.* The court went to some length to differentiate the “right of publicity” from the dignitary aspects of the “right of privacy,” and thus focused on the economic advantages derived from public exposure. *Id.*

economic realities of the case, the court observed that "[t]his right of publicity would usually yield [persons] no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures."²¹

C. The Supreme Court Position

A few jurisdictions followed the Second Circuit's lead in *Haelan Laboratories* and adopted a similar articulation of the right of publicity,²² but widespread judicial acceptance of a right of publicity did not come until the Supreme Court's decision in *Zacchini v. Scripps-Howard Broadcasting Co.*²³ In *Zacchini*, petitioner performed a "human cannonball" act at an Ohio county fair, carrying on an act "invented by his father and . . . performed only by his family for the last fifty years."²⁴ Zacchini's performances lasted about fifteen seconds each, during which "he [was] shot from a cannon into a net some 200 feet away."²⁵ Zacchini specifically objected to any taping of his performance, yet an area television station aired a tape of Zacchini's flight as part of its coverage of the county fair.²⁶ After the broadcast, Zacchini claimed that the station's film clip constituted "an 'unlawful appropriation of [his] professional property'"²⁷ and filed suit seeking \$25,000 in damages²⁸ for "invasion of privacy, contending that the defendant had appropriated the plaintiff's professional talents for its own

²¹ *Id.*

²² In the Third Circuit, the litigation of *Sharman v. C. Schmidt & Sons*, 216 F. Supp. 401 (E.D. Pa. 1963), showed Pennsylvania's recognition of the right of publicity: "[p]ublic figures in the celebrity category have a valuable property right in their name and image." *Id.* at 407. In the Eighth Circuit, *Cepeda v. Swift & Co.*, 415 F.2d 1205 (8th Cir. 1969), showed the court's acknowledgment of the right of publicity, although it found no infringement. *Id.* at 1206-08. In *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974), the Ninth Circuit cited *Haelan Labs.* with approval, finding basis for a right of publicity. *Id.* at 825. *Contra Memphis Dev. Found. v. Factors, Etc., Inc.*, 441 F. Supp. 1323, 1326 (W.D. Tenn. 1977) ("The right of publicity is not a 'property right.'"), *rev'd*, 616 F.2d. 956 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980).

²³ 433 U.S. 562 (1977).

²⁴ *Id.* at 563-64 (quoting appellant's brief).

²⁵ *Id.* at 563.

²⁶ *Id.* at 563-64.

²⁷ *Id.* at 564 (quoting appellant's brief).

²⁸ *Id.* at 575 n.12.

use.”²⁹ Based on its finding of a “newsworthiness” exception for the press, the Ohio Supreme Court found for the defendant: “[a] TV station has a privilege to report in its newscasts matters of legitimate public interest which would otherwise be protected by an individual’s right of publicity.”³⁰ Specifically, the court defended the station’s taped use of Zacchini’s entire flight by stating that the press “must be accorded broad latitude in its choice of how much it presents of each story or incident.”³¹ The court did, however, acknowledge that the right of publicity attached to Zacchini’s act, and it would have been protected, save for the overriding interests of the press. On appeal to the United States Supreme Court, attention then focused on whether First Amendment “newsworthiness” trumped petitioner’s right of publicity.³²

The Supreme Court’s pragmatic reasoning overruled the Ohio court’s determination and confirmed Zacchini’s right of publicity.³³ Observing the brief nature of Zacchini’s act, the Court decided that broadcasting the “entire performance . . . goes to the heart of petitioner’s ability to earn a living as an entertainer”;³⁴ such broadcasting posed “a substantial threat to the economic value of that performance.”³⁵ Further, “if the public can see the act free on television, it will be less willing to pay to see it at the

²⁹ *Zacchini v. Scripps-Howard Broadcasting Co.*, 351 N.E.2d 454, 456 (Ohio 1976) (syllabus of the court), *rev’d*, 433 U.S. 562 (1977).

³⁰ *Id.* at 455 (syllabus of the court). The court’s opinion went on to explain that a television station abuses this privilege if it knowingly disseminates falsehoods or if its actual intent was to “appropriate the benefit of the publicity for some non-privileged private use.” *Id.*

³¹ *Id.* at 461.

³² This is not to say that the First Amendment’s relationship to the right of publicity was the sole issue of concern on appeal. Prefatory to its analysis of the right of publicity, the Court addressed concerns involving Supreme Court decisions on state matters. Although rights of publicity are grounded in state law, the Ohio Supreme Court’s judgment “did not rest on an adequate and independent state ground, thereby giving the Court jurisdiction to decide the federal issue presented in this case.” *Zacchini*, 433 U.S. at 566. Essentially, the First Amendment defense was the avenue of Court jurisdiction.

³³ Nowhere in this opinion is the Court’s pragmatic view more obvious than in its characterization of the case’s equities: “[i]ndeed, in the present case petitioner did not seek to enjoin the broadcast of his act; he simply sought compensation for the broadcast in the form of damages.” *Id.* at 573–74. Court opinions in cases decided upon the right of publicity appear especially likely to view the equities in this manner.

³⁴ *Id.* at 576.

³⁵ *Id.* at 575.

fair.”³⁶ The Court then balanced the public’s interest in the “newsworthiness” of Zacchini’s flight against his right of publicity and found that there was no justifiable elevation of the press’s interests over Zacchini’s.³⁷ By airing Zacchini’s entire performance, the Court held that the newscast violated his right of publicity.³⁸

D. Further Developments

In the years since *Zacchini*, the right of publicity has undergone several refinements. Chief among these are a recognition of “sound alike” as breaches of the right of publicity and a determination of the right of publicity’s descendibility.

1. “Sound Alikes”: *Midler v. Ford Motor Co.*

In *Midler v. Ford Motor Co.*,³⁹ singer and actress Bette Midler sued Ford for its breach of her right of publicity based on its use of a “sound alike” to substitute for Midler’s vocal performance in a commercial. Initially, Ford’s advertising agency tried to negotiate a contract with Midler to sing in its commercial.⁴⁰ Thwarted by her adamant refusal, Ford hired one of Midler’s former backup singers; this singer was requested to perform Midler’s “Do You Want to Dance” and to “sound as much as possible like the Bette Midler record.”⁴¹ The innovative aspect of this case

³⁶ *Id.* In a footnote to this quotation, the Court addressed what effect a finding that the broadcast had helped plaintiff’s livelihood would have: “[i]n these circumstances, petitioner would not be able to prove damages and thus would not recover.” *Id.* at 575 n.12.

³⁷ “No social purpose is served by having the defendant get [for] free some aspect of the plaintiff that would have market value and for which he would normally pay.” *Id.* at 576 (quoting *Kalven*, *supra* note 8, at 331).

³⁸ *See id.* at 574–76.

³⁹ 849 F.2d 460 (9th Cir. 1988). For a thorough analysis of *Midler*’s place in the right of publicity litigation history, see Terri E. Hilliard, Note, *Advertisers Beware: Bette Midler Doesn’t Want to Dance*, 9 LOY. L.A. ENT. L.J. 43 (1989), and Leonard A. Wohl, Note, *Federal Preemption of the Right of Publicity in Sing-Alike Cases*, 1 FORDHAM ENT. MEDIA & INTELL. PROP. L.F. 47 (1990).

⁴⁰ The commercial in question was part of Ford’s “Yuppie Campaign”—“[t]he aim was to make an emotional connection with Yuppies, bringing back memories of when they were in college.” *Midler*, 849 F.2d at 461. To this end, Ford wanted to use Ms. Midler’s rendition of “Do You Want To Dance” to trigger wistful memories of the seventies.

⁴¹ *Id.*

was the court's decision that purposeful mimicry of a person's voice was an actionable tort in California based on the common law right of publicity—not California's tortious appropriation statute.⁴² Citing the controlling Supreme Court decision on the freedom of speech and press,⁴³ the court articulated the First Amendment's position in right of publicity cases as validating the use of others' identities "[i]f the purpose is 'informative or cultural.'"⁴⁴ If, however, the appropriation does not satisfy this public good, then it is subject to restriction by the right of publicity.⁴⁵ In the tradition of *Zacchini*, the court's logic was quite pragmatic and emphasized that the defendant specifically sought to appropriate the distinctive value of Midler's voice, given their solicitation of Midler's and the "sound alike's" services. Further, the court described the human voice as an inseparable part of identity and held that "[t]o impersonate her voice is to pirate her identity."⁴⁶

2. *Descendibility*: *Lugosi v. Universal Pictures*

The issue in *Lugosi v. Universal Pictures*⁴⁷ was whether publicity rights are descendible, and therefore could be exploited and enforced by a celebrity's descendants.⁴⁸ In *Lugosi*, heirs sought to enjoin defendants from

⁴² The law referenced here is section 3344 of the California Civil Code which grants damages when one uses a "name, voice, signature, photograph, or likeness, in any manner" without consent or permission. CAL. CIV. CODE § 3344(a) (West Supp. 1994). This law is similarly construed in *White* and is discussed *infra* at note 63. See also *infra* note 70.

⁴³ *Time, Inc. v. Hill*, 385 U.S. 374, 387–88 (1967) (holding that the false reporting of a family's experience as hostages did not constitute libel without proof that *Life* magazine printed the story with malice).

⁴⁴ *Midler*, 849 F.2d at 462 (quoting Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1596 (1979)).

⁴⁵ See *id.*

⁴⁶ *Id.* at 463.

⁴⁷ 603 P.2d 425 (Cal. 1979). Other cases in this area include *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1355–61 (D.N.J. 1981) (holding that the right of publicity is descendible and that the defendant's production, "The Big El Show," likely infringed the right). *Contra* *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956 (6th Cir.), cert. denied, 449 U.S. 953, 957 (1980) (holding that the right of publicity is not descendible in a case concerning pewter replicas of Elvis Presley).

⁴⁸ A commentator has aptly called these cases, and those similar to them, "*post mortem* 'star' wars, the ghoulish pursuit of profit from the persona of a deceased celebrity." Halpern, *supra* note 13, at 1215.

issuing merchandising licenses for the Count Dracula character as portrayed by Bela Lugosi.⁴⁹ Relying on Prosser's analysis of privacy rights,⁵⁰ the court emphasized the personal nature of the right: "[t]he right is not assignable . . . *there is no common law right of action for a publication concerning one who is already dead.*"⁵¹ In its decision, the court emphasized the personal nature of the right of publicity, dependent as it is on the efforts of its creator.⁵² Once Lugosi died, the court declared that "his name was in the public domain . . . [a]nyone . . . could use it for a legitimate commercial purpose."⁵³

Unfortunately, *Lugosi* is not the universal state of the law; other jurisdictions have reached contrary decisions based on their state's interpretation of right of publicity law.⁵⁴ In *Estate of Presley v. Russen*,⁵⁵ the court found the right of publicity to be inheritable because of its status as a property right.⁵⁶ In its decision, the court favorably cited to Chief Judge Bird's dissent in *Lugosi* for the proposition that "[t]he financial benefits of [the] labor [to create one's celebrity status] should go to the celebrity's heirs."⁵⁷ Because the right of publicity arises out of common law, the area is likely to remain uncertain until either Congress or the Supreme Court acts.

⁴⁹ *Lugosi*, 603 P.2d at 427. The defendant did not contest that it was indeed the Lugosi version of Count Dracula that it sought to license, rather than that of any other actor who had played Count Dracula. *Id.*

⁵⁰ See Prosser, *supra* note 8.

⁵¹ *Lugosi*, 603 P.2d at 429 (quoting PROSSER, THE LAW OF TORTS 814-15 (4th ed. 1971) (emphasis added in opinion)); see also Halpern, *supra* note 13, at 1219-23.

⁵² *Lugosi*, 603 P.2d at 430.

⁵³ *Id.*

⁵⁴ A full discussion of this thorny aspect of the right of publicity is beyond the scope of this paper; for a complete analysis see Halpern, *supra* note 13, at 1215-37.

⁵⁵ 513 F. Supp. 1339 (D.N.J. 1981).

⁵⁶ *Id.* at 1355.

⁵⁷ *Id.* (quoting *Lugosi*, 603 P.2d at 446 (Bird, C.J., dissenting)).

III. *WHITE V. SAMSUNG ELECTRONICS AMERICA, INC.*: ITS PLACE IN THE RIGHT OF PUBLICITY DEBATE

A. *The Majority Opinions*

The plaintiff in this case,⁵⁸ Vanna White—the well-known hostess of television's "Wheel of Fortune" game show—sought to enforce her right of publicity against the defendant for appropriation of her identity in its advertising campaign. As part of a national campaign, Samsung published a series of advertisements which attested to their products' longevity by showing the products in a useful state well into the twenty-first century.⁵⁹ All of the advertisements were done in a humorous vein, suggesting amusing future events, and the one of which White complained was no exception. In this advertisement, a robot was shown on a stage "instantly recognizable as the Wheel of Fortune game show set";⁶⁰ the ad's caption read, "Longest-running game show. 2012 A.D."⁶¹ Further, and crucial to the Ninth Circuit's decision, the robot was dressed to emulate White's standard game show costume—evening gown and jewelry.⁶² At the district court level, the defendant won its summary judgment motion; the Ninth Circuit reversed this ruling and held that White had a viable claim under California's common law right of publicity.⁶³

⁵⁸ *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

⁵⁹ *White*, 971 F.2d at 1396. The ads in this series humorously "hypothesiz[ed] outrageous future outcomes." *Id.* Other ads in this series included a picture of raw steak captioned "Revealed to be health food. 2010 A.D.," and a theoretical future campaign poster depicting actor Morton Downey, Jr. with the legend "Presidential candidate. 2008 A.D." *Id.*

⁶⁰ *Id.*

⁶¹ *Id.*

⁶² "The gag here, I take it, was that Samsung would still be around when White had been replaced by a robot." *White*, 989 F.2d at 1514 (Kozinski, J., dissenting). The ad in question, shown alongside of Ms. White's picture, is attached to the opinion. *Id.* at 1522–23.

⁶³ Ms. White also appealed the dismissal of her case based on section 3344(a) of the California Civil Code, where "[a]ny person who knowingly uses another's name . . . or likeness . . . for purposes of advertising or selling, . . . without such person's prior consent . . . shall be liable for any damages." CAL. CIV. CODE § 3344(a) (West Supp. 1994). The court affirmed dismissal of Ms. White's cause of action under that provision, since "the robot at issue here was not White's 'likeness' within the meaning of § 3344." *White*, 971 F.2d at 1397. Ms. White also appealed the dismissal of her case based on trademark violations of the Lanham Act, 15 U.S.C.

The major hurdle the Ninth Circuit had to overcome was the fact that in no way could a robot be mistaken for Vanna White, therefore it was more difficult to construe an appropriation of identity. Using *Midler v. Ford Motor Co.*⁶⁴ as a starting point, the court reasoned that “[t]he right of publicity does not require that appropriations of identity be accomplished through particular means to be actionable.”⁶⁵ In explanation of its position, the court observed that an appropriation was no less invasive when it “avoided the most obvious means of appropriating the plaintiff[s] identit[y].”⁶⁶ By recognizing publicity rights in more than names and likenesses, the court argued that it was only acknowledging the previous developments in *Midler* and stopping the “evisceration of the common law right of publicity through means as facile as those in this case.”⁶⁷

B. *The Dissenting Opinions*

Adamant dissents were filed in both the Ninth Circuit opinion and the subsequent motion for rehearing en banc. Judge Alarcon’s dissent in the original case focused on the gap in the court’s logic regarding its finding that there was an appropriation of identity, even though the ad did not portray a “likeness” of Vanna White.⁶⁸ Judge Alarcon questioned the majority’s extension of California common law to include appropriations of personality aspects other than names or likenesses.⁶⁹ Citing California’s tortious appropriation law as the legislative statement on the matter, his dissent criticized the majority’s new application of common law.⁷⁰

§ 1125(a) (1988); the court found genuine issues of material fact here and remanded for a decision. *White*, 971 F.2d at 1399–1401.

⁶⁴ 849 F.2d 460 (9th Cir. 1988).

⁶⁵ *White*, 971 F.2d at 1398. To illustrate how the instant facts constituted an appropriation, the court hypothesized a commercial depicting a “robot with male features, an African-American complexion, and a bald head . . . wearing black hightop Air Jordan basketball sneakers, and a red basketball uniform with black trim, . . . and the number 23.” *Id.* at 1399. Even without lettering proclaiming “Bulls” or “Jordan” on the jersey, the court argued, all of the elements taken together with the filming of the robot making a slam dunk lead to the inescapable linking of the ad with Michael Jordan. *Id.*

⁶⁶ *Id.* at 1398.

⁶⁷ *Id.* at 1399.

⁶⁸ *Id.* at 1403 (Alarcon, J., concurring in part, dissenting in part).

⁶⁹ *Id.*

⁷⁰ The distinction between section 3344 of the California Civil Code and the common law right of publicity was explained in *Eastwood v. Superior Court*, 149 Cal. App. 3d 409 (1983): the statute requires cognizant appropriation, while ignorance is

In the petition for rehearing, Judge Kozinski wrote in dissent to the denial of the petition.⁷¹ The crux of Judge Kozinski's dissent was that "[t]he panel's opinion is a classic case of overprotection."⁷² By pulling Ms. White's tort under the right of publicity's umbrella, he found that "it's now a tort for advertisers to *remind* the public of a celebrity."⁷³ Much of Judge Kozinski's dissent focused on the harm done to the First Amendment by the court's decision. Judge Kozinski was quite willing to admit that the First Amendment does not sanction the appropriation of "one particular way of expressing an idea,"⁷⁴ but it also should not permit one to monopolize an idea to the point that any expression evoking that idea constitutes an appropriation of property.⁷⁵ Judge Kozinski further argued that part of the policy motivating the First Amendment protections is to "protec[t] the free development of our national culture."⁷⁶ Out of this policy, Judge Kozinski fashioned an argument that the First Amendment provides shelter for parody and humor, thus protecting ads like Samsung's over conflicting publicity rights.⁷⁷

Judge Kozinski's First Amendment discussion also dealt with the majority's cursory treatment of Samsung's First Amendment defense. The majority in *White* dismissed Samsung's First Amendment argument nearly out of hand, based on the observation that this advertisement was "run for the purpose of selling Samsung VCRs."⁷⁸ Under the majority's logic, there was no First Amendment protection for commercial speech. This logic, however, is not in accord with the Supreme Court's rulings.

In *Central Hudson Gas & Electric Corp. v. Public Service Commission*,⁷⁹ the Supreme Court articulated the test for the First

not a defense at common law; section 3344 remedies are specifically made cumulative to other remedies. *Id.* at 417 n.6.

⁷¹ Judges O'Scannlain and Kleinfeld joined in his dissent. *White v. Samsung Electronics America, Inc.*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

⁷² *Id.* at 1514 (Kozinski, J., dissenting).

⁷³ *Id.*

⁷⁴ *Id.* at 1519. Evidence that the First Amendment does not extend this far, Judge Kozinski argued, is that the American legal system recognizes a structured form of protection for trademarks, copyrights, and patents.

⁷⁵ *See id.*

⁷⁶ *Id.*

⁷⁷ *Id.* at 1520.

⁷⁸ *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395, 1401 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

⁷⁹ 447 U.S. 557 (1980). This case dealt with the constitutionality of defendant's order banning advertising which promoted the use of electricity by electric companies.

Amendment's protection of commercial speech. Under this test, a court should first determine if the communication—the speech at issue—is misleading or related to unlawful activity. If either is true, then the state has the power to sharply curtail the communication.⁸⁰ If, however, neither is true, then the “[s]tate must assert a substantial interest to be achieved by restrictions on commercial speech.”⁸¹ Finally, any regulation must bear a proportionate relationship to the state interest at hand.⁸² As a test of proportionality, there is a mandate to use only the least restrictive means to regulate commercial speech.⁸³ Under *Central Hudson*'s test, commercial speech receives less protection than political commentary or religious testimonials, but there is some protection for it.⁸⁴

In its evaluation of Samsung's First Amendment rights, which the defendant argued as its right to parody, the *White* majority did not employ the *Central Hudson* test; it did not examine whether the restrictions were justified by important state interests, nor was any mention made of least restrictive means.⁸⁵ In Judge Kozinski's words, the Court had formulated the *Central Hudson* test “because it saw lower courts were giving the First Amendment short shrift when confronted with commercial speech.”⁸⁶ The majority in *White*, despite the guidance of *Central Hudson*, failed to respect the First Amendment.

Id. at 558–59. The Court held that such an action violated the First Amendment rights of the utility company, based on the First Amendment's protection of commercial speech. *Id.* at 570–72.

⁸⁰ *Id.* at 564.

⁸¹ *Id.*

⁸² *Id.*

⁸³ *Id.* The explanation of this test goes on to state that the determination of proportionality may be done by examining whether the restriction advances the state interest, and if such advancement could be “served as well by a more limited restriction on commercial speech.” *Id.*

⁸⁴ *Id.* at 563.

⁸⁵ The majority does mention *Central Hudson*, but only in a footnote to support its assertion that commercial speech is given less protection under the First Amendment. *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395, 1401 n.3 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

⁸⁶ *White v. Samsung Electronics America, Inc.*, 989 F.2d 1512, 1520 (9th Cir.) (Kozinski, J., dissenting), *cert. denied*, 113 S. Ct. 2442 (1993).

IV. FIRST AMENDMENT DEFENSES IN COPYRIGHT AND RIGHT OF PUBLICITY LITIGATION

Protection of the right of publicity is very similar to the protection of copyright.⁸⁷ The goals are similar: both try to encourage an individual's creative efforts with the assurance that their investments will be protected in the form of limited monopolies. A primary difference between the two, however, is that the statutory copyright system has made a sincere effort to accommodate First Amendment concerns into its structure, whereas the common law development of rights of publicity has not provided similar safeguards.

A. *Copyright Law's Treatment of First Amendment Concerns*

Works have copyright protection if they are "original works of authorship fixed in any tangible medium of expression."⁸⁸ Federal law controls copyright protection to the exclusion of state law. The codification of copyright gives protection for a limited time to an author who publishes her work; after the copyright expires, the work falls into the public domain, where all are free to use it.⁸⁹ Insulation of First Amendment rights in the federal scheme is accomplished primarily through two theories: the idea/expression doctrine and the fair use doctrine.⁹⁰ These two doctrines are frequently the focus of attention in copyright litigation involving parodies, where the courts struggle to reconcile First Amendment concerns with an author's copyright. The Supreme Court ruling concerning the

⁸⁷ *Zacchini v. Scripps-Howard Broadcasting, Co.*, 443 U.S. 562, 576 (1977). Here, the Court observed that the protection of a right of publicity "provides an economic incentive for [the performer] to make the investment required to produce a performance," and that "[t]his same consideration underlies the patent and copyright laws long enforced by this Court." *Id.*

⁸⁸ 17 U.S.C. § 102(a) (1988). This basic definition of copyright demands that the work be original, with minimal creativity (i.e., with some evidence of intellectual labor, be the author's own, and be fixed (exist in tangible form)). The primary purpose of the current version of copyright law—the 1976 version—was to kill off any remaining vestige of common law copyright. SHELDON W. HALPERN ET AL., COPYRIGHT CASES AND MATERIALS 43–44 (1992).

⁸⁹ 17 U.S.C. §§ 301–305 (1988).

⁹⁰ See *infra* parts IV.A.1–2.

specific treatment of parody under the First Amendment and copyright law is of great importance here.⁹¹

1. *The Idea/Expression Doctrine*

The idea/expression doctrine is meant to limit the scope of copyright and thereby the scope of monopolies; the law states that “[i]n no case does copyright protection . . . extend to any idea, . . . principle, or discovery.”⁹² Essentially, a copyright cannot exist on ideas, but only on the expression of the idea; if the expression can only be conveyed in a few ways, then the idea is said to have merged into its expression.⁹³ When such merger occurs, a copyright of the work is unavailable because it would take the idea out of the public domain; neither law nor public policy can allow a monopoly on such an expression.⁹⁴

Courts have frequently cited to the idea/expression doctrine as a primary guarantor of First Amendment rights. In *Sid & Marty Krofft Television Prods. v. McDonald's Corp.*,⁹⁵ the Ninth Circuit relied on this doctrine to support its finding of infringement, as the defendant had taken more than the idea from the plaintiff, and had instead taken copyrightable expression. In its analysis, the court succinctly summarized the protection of the First Amendment by the idea/expression doctrine:

⁹¹ *Campbell v. Acuff-Rose Music, Inc.*, 754 F. Supp. 1150 (M.D. Tenn. 1991), *rev'd*, 972 F.2d 1429 (6th Cir. 1992), *rev'd*, 114 S. Ct. 1164 (1994) (9-0 decision).

⁹² 17 U.S.C. § 102(b) (1988).

⁹³ Cases in this area include: *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991) (the publication of baseball game outcome predictions based on a number of statistics is copyrightable only in response to nearly verbatim copying); *Morrissey v. Procter & Gamble*, 379 F.2d 675 (1st Cir. 1967) (contest rules were not copyrightable as there are only a few ways to state such rules); *Matthew Bender & Co. v. Kluwer Law Book Publishers, Inc.*, 672 F. Supp. 107 (S.D.N.Y. 1987) (the data in personal injury charts and its ordering is not protectable because of the limited ways to convey such information).

⁹⁴ When merger is found, courts are split over how to treat the works in issue. One theory (the “infringement view”) holds that the copyright stands on the material, but it will only be enforced if there is verbatim copying. The Second Circuit and the highly respected writings of Melville Nimmer endorse this view. A second theory (the “copyright view”) states that such merging expressions cannot get a copyright at all, and are thus dedicated to the public domain from the start, no matter how much labor was required in the work’s production. HALPERN, *supra* note 88, at 84.

⁹⁵ 562 F.2d 1157 (9th Cir. 1977) (plaintiff alleged that defendant’s “McDonaldland” characters infringed copyrights in plaintiff’s “H.R. Pufnstuf” characters).

[T]he idea-expression line represents an acceptable definitional balance as between copyright and free speech interests. In some degree it encroaches upon freedom of speech in that it abridges the right to reproduce the "expression" of others, but this is justified by the greater public good in the copyright encouragement of creative works. In some degree it encroaches upon the author's right to control his work in that it renders his "ideas" per se unprotectible, but this is justified by the greater public need for free access to ideas as part of the democratic dialogue.⁹⁶

2. The Fair Use Doctrine

Typically, the fair use defense is the first defense employed in response to copyright infringement charges; this defense is codified in the current version of the copyright law.⁹⁷ Essentially, the defendant acknowledges his taking of the author's work, but in defense claims that his use is sanctioned by federal law, as his use is a productive activity, and thus is valuable to society. It must be realized that the statutory enactment of the fair use test does not give judges a bright line test; fair use is still explored on a case-by-case basis.⁹⁸ An example of this analysis can be seen in *Maxtone-Graham v. Burtchaell*,⁹⁹ in which the Second Circuit employed the copyright act's four part test to determine if a given use constituted a "fair use."

The elements of this test are first, what the purpose and character of the infringing use is—commercial, non-profit, or educational. *Maxtone-Graham* indicates that a commercial use is presumptively unfair, but that this presumption is rebuttable.¹⁰⁰ Second, the court must examine the nature of the original work; a factual work would get less protection, as less of it is copyrightable.¹⁰¹ Third, the court must examine the amount

⁹⁶ *Id.* at 1170 (quoting Melville Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180, 1192-93 (1970)).

⁹⁷ 17 U.S.C. § 107 (1988). This section sets forth a four part test for fair use, 17 U.S.C. § 107(1)-(4). Prior to this statute, fair use was "exclusively judge-made doctrine." *Campbell v. Acuff-Rose Music, Inc.*, 114 S. Ct. 1164, 1170 (1994).

⁹⁸ *Acuff-Rose*, 114 S. Ct. at 1170.

⁹⁹ 803 F.2d 1253 (2d Cir. 1986), *cert. denied*, 481 U.S. 1059 (1987). In this case, a priest copied from a series of interviews with women who had gone through abortions and adoptions for use in his pamphlet decrying abortion's legality. The defendant had asked permission to use the material, but it was denied. *Id.* at 1256-57.

¹⁰⁰ *Id.* at 1260-62. As will be later discussed, the Supreme Court decision in *Acuff-Rose*, accentuates this point when parody analysis is at issue. *See infra* text accompanying notes 117-22.

¹⁰¹ *See Maxtone-Graham*, 803 F.2d at 1262-63.

and substantiality of copying. Here, the raw amount taken is not the issue, but whether the "heart of the work" was taken.¹⁰² Finally, the court needs to determine what the effect on the potential market of the copyrighted work will be, given the infringement.¹⁰³ The focus of this element is what harm the original author has suffered.

Although each of the above four elements is to be evaluated separately, all four are to be considered in the ultimate determination of the fair use defense.¹⁰⁴ In reality, however, the first and fourth elements—purpose of use and effect on the market—have emerged as the most important portions of the test; commercial gain for the infringer almost inevitably leads to a presumption of harm to the original author and thereby to denial of the fair use defense.¹⁰⁵ While it is difficult for the commercial infringer to gain protection here, it should be possible, depending on how the balancing of the four elements plays out. The Supreme Court's holding in *Campbell v. Acuff-Rose Music, Inc.* is extremely influential on this point, as the overriding theme of the decision is that a commercial purpose will not, on its own, prevent a finding of fair use.¹⁰⁶

The First Amendment's concern for the free exchange of ideas fits well into the fair use analysis, as the infringer's purpose in appropriation is of primary importance. It is for this reason that a court's First Amendment analysis is often collapsed into fair use analysis, which places a great deal of emphasis on any commercial elements found in the appropriation.¹⁰⁷ Thus, the First Amendment analysis is often subsumed by fair use's "purpose of the use" element, and often commercial speech does not receive even *Central Hudson*'s protection.¹⁰⁸

¹⁰² *Id.* at 1263.

¹⁰³ *Id.* at 1263-64.

¹⁰⁴ *Campbell v. Acuff-Rose Music, Inc.*, 114 S. Ct. 1164, 1170-71 (1994).

¹⁰⁵ *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984) (5-4 decision). Universal alleged Sony to be a contributory infringer based on its sales of Betamax VTRs. The Supreme Court found no infringement because there was a fair use available to the consumers of the VTRs—namely the taping of programs for later viewing. *Id.* at 417, 447-55.

¹⁰⁶ *Acuff-Rose*, 114 S. Ct. at 1173-79.

¹⁰⁷ Courts are often reluctant to address constitutional issues directly. Legal constructs like the fair use doctrine are therefore attractive, since using them allows courts to avoid confronting the constitutional issue.

¹⁰⁸ See *supra* text accompanying notes 80-86; see also Pamela Samuelson, *Reviving Zacchini: Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases*, 57 TUL. L. REV. 836, 883-90 (1983).

3. Recent Developments: *Campbell v. Acuff-Rose Music, Inc.*

In *Acuff-Rose*,¹⁰⁹ the Supreme Court analyzed the state of parodies within the copyright regime. Parody holds an interesting position in copyright law.¹¹⁰ In litigation involving parodies, the defendant's theory is that her use is a statutory fair use, but not entirely based on analogues to *Maxtone-Graham*'s four elements. Rather, the defendant argues that her use is fair because of the four elements and because it is a parody.¹¹¹ The majority position is that a protected parody can at least "conjure up" the visage of the parodied work¹¹² by taking from the original work. Protection extends beyond this threshold point to some level short of a total appropriation.¹¹³

In *Acuff-Rose*, the Sixth Circuit had ruled against the defendant's fair use defense since the commercial use outweighed any findings in the infringer's favor: "[i]t is the blatantly commercial purpose of the derivative

¹⁰⁹ *Campbell v. Acuff-Rose Music, Inc.*, 754 F. Supp. 1150 (M.D. Tenn. 1991), 972 F.2d 1429 (6th Cir. 1992), *rev'd*, 114 S. Ct. 1164 (1994). At issue was "2 Live Crew's" rap version of Roy Orbison's classic "Oh, Pretty Woman." Acuff-Rose owned the copyright in "Oh, Pretty Woman," and refused to license the "2 Live Crew" version of the song. *Acuff-Rose*, 754 F. Supp. at 1152. "2 Live Crew" recorded "Pretty Woman" anyway and released it in 1989. *Id.* As a result, Acuff-Rose filed suit for infringement of its copyright. *Id.*

¹¹⁰ In copyright law, the definition of parody is the same as that used in common parlance. A parody is a work which closely imitates another work for "comic effect or in ridicule." WEBSTER'S NINTH NEW COLLEGIATE DICTIONARY 851 (1988).

¹¹¹ *Campbell v. Acuff-Rose Music, Inc.*, 114 S. Ct. 1164, 1169 (1994).

¹¹² There is a split of authority on this issue, primarily between the Second and Ninth Circuits—the centers of copyright litigation. The Ninth Circuit previously held that a parody was a permissible infringement so long as the parody did no more than "conjure up" the essence of the original. *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 757 (9th Cir. 1978), *cert. denied*, 439 U.S. 1132 (1979). This court's current position, which shows a gravitation toward the Second Circuit position, is that the amount and substantiality of the taking are of primary importance, and that it is acceptable for that amount to be some amount more than enough to "conjure up" the memory of the original. *Fisher v. Dees*, 794 F.2d 432, 438–39 (9th Cir. 1986). The Second Circuit's position on this issue provides more protection for parodies. *See Elsmere Music, Inc. v. National Broadcasting Co.*, 482 F. Supp. 741 (S.D.N.Y.) (holding that Saturday Night Live's parody of Frank Sinatra's "I Love New York" (into a skit "I Love Sodom") did not infringe), *aff'd*, 623 F.2d 252 (2d Cir. 1980); *see also* HALPERN, *supra* note 88, at 508.

¹¹³ *See Elsmere*, 482 F. Supp. at 745–47.

work that prevents this parody from being a fair use.”¹¹⁴ The Supreme Court accepted review of *Acuff-Rose* on the sole question of whether a commercial parody could ever constitute a fair use of the original work.¹¹⁵

Writing for an unanimous court, Justice Souter first addressed the use of the statutory fair use test as a whole, stressing that all four elements were to be weighed together when analyzing fair use cases.¹¹⁶ Examining each element in turn, Justice Souter discussed the treatment of parodies under the fair use test.

First, in regard to the nature of the use,¹¹⁷ Justice Souter criticized the Sixth Circuit’s analysis that the work here was a commercial use.¹¹⁸ The Court’s argument here was based on the plain language of the statute, which states that courts are to determine “the purpose and character of the use, *including* whether such use is of a commercial nature.”¹¹⁹ This statement suggests that although a court may look at the commercial aspect to determine the “purpose and character” of a use, there is more to the analysis. This element is supposed to convey a sense of what the alleged infringer actually did with the taken material. According to Justice Souter, a preferred use under this element is one which goes beyond the original and “adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message. . . . Such works . . . lie at the heart of the fair use doctrine’s guarantee of breathing space.”¹²⁰ Fitting parody into this analysis, Justice Souter stressed that

¹¹⁴ *Campbell v. Acuff-Rose Music, Inc.*, 972 F.2d 1429, 1439 (6th Cir. 1992), *rev’d*, 114 S. Ct. 1164 (1994).

¹¹⁵ *Acuff-Rose*, 114 S. Ct. at 1169.

¹¹⁶ *Id.* at 1169–71. Justice Kennedy wrote a separate concurrence, and cautioned that parodies cannot be given wider shelter under the fair use defense. *Id.* at 1181–82 (Kennedy, J., concurring).

¹¹⁷ 17 U.S.C. § 107(1) (1988).

¹¹⁸ In Justice Souter’s words:

The Court of Appeals . . . immediately cut short the enquiry into 2 Live Crew’s fair use claim by confining its treatment of the first factor essentially to one relevant fact, the commercial nature of the use. . . . In giving virtually dispositive weight to the commercial nature of the parody, the Court of Appeals erred.

Acuff-Rose, 114 S. Ct. at 1173–74.

¹¹⁹ 17 U.S.C. § 107(1) (1988) (emphasis added).

¹²⁰ *Acuff-Rose*, 114 S. Ct. at 1171.

"parody has an obvious claim to transformative value."¹²¹ When applying the fair use test, this claim must be remembered as part of the nature of the work. A parody should not receive special consideration, but will have to pass the same fair use test as any other work.¹²²

Concerning the second element, "the nature of the copyrighted work,"¹²³ Justice Souter found its policy to be one of protection for certain works "closer to the core of intended copyright protection than others."¹²⁴ Examples of such works are forthcoming publications¹²⁵ and private letters.¹²⁶ The point of this element is to make it harder to establish a fair use when certain types of works have been used. In regard to parody, Justice Souter observed that this element "is not much help . . . in separating the fair use sheep from the infringing goats in a parody case."¹²⁷

Analyzing the third element, the amount taken,¹²⁸ the Court observed that the nature of the work does much to determine what is an acceptable amount.¹²⁹ Applying this element requires a look at both the amount of material taken and its quality, with the goal being to see if the work is a slight repackaging of the original, or if it is a distinct development over the original. The Court found that because parody requires a "recognizable sight or sound," "[c]opying does not become excessive in relation to parodic purpose merely because the portion taken was the original's heart."¹³⁰ Based on this conclusion, Justice Souter again criticized the

¹²¹ *Id.* Earlier in this passage of his opinion, Justice Souter defined "transformative value" in terms of those works which add to the original work's expression. *Id.*

¹²² *Id.* at 1172.

¹²³ 17 U.S.C. § 107(2) (1988).

¹²⁴ *Acuff-Rose*, 114 S. Ct. at 1175.

¹²⁵ See *Harper & Row Publishers, Inc. v. Nation Enter.*, 471 U.S. 539 (1985) (holding that defendant infringed by taking quotations from an unpublished manuscript).

¹²⁶ See *Salinger v. Random House, Inc.*, 811 F.2d 90 (2d Cir. 1987) (finding infringement of plaintiff's copyright based on appropriation from unpublished letters, despite the fact that the letters were given to university libraries).

¹²⁷ *Acuff-Rose*, 114 S. Ct. at 1175. A parody usually targets an expressive work, worthy of copyright protection. Thus, it is rare for this element to be of great concern in fair use litigation.

¹²⁸ 17 U.S.C. § 107(3) (1988).

¹²⁹ *Acuff-Rose*, 114 S. Ct. at 1175-77.

¹³⁰ *Id.* at 1176.

narrow analysis of the Sixth Circuit, but remanded for evaluation on this element.¹³¹

Turning to the fourth element, the market effect,¹³² the Court noted a lack of defendant's evidence on this point. The defendant provided only "uncontroverted submissions that there was no likely effect on the market for the original,"¹³³ yet failed to address the effect of its work on derivative works. This last element requires a defendant to show both present harm, or lack thereof, and future effect. On this point, the Court observed, "[t]he evidentiary hole will doubtless be plugged on remand."¹³⁴ In addition, the Court found fault with the Sixth Circuit decision, because it presumed that the first element—"commercial use"—dictated a finding against the defendant.¹³⁵ This presumption was not an uncommon position for courts to hold on this element, but Justice Souter left no doubt on this point: "[n]o 'presumption' or inference of market harm . . . is applicable to a case involving something beyond mere duplication for commercial purposes."¹³⁶

The *Acuff-Rose* decision is extremely important to the copyright world. Although the four element test for fair use is still without bright lines, Justice Souter's opinion does give courts some guidelines to emulate and addresses some of the questionable court habits in applying the fair use test. Further, this opinion, while not granting parody any special treatment under the fair use law, ensures that parody cases will be on equal footing with other cases under fair use analysis.¹³⁷ Justice Kennedy's concurrence reinforces this position.¹³⁸ Giving parodies this opportunity for fair use protection will foster fair use's integration of First Amendment concerns, reiterating copyright law's balance between creativity and rights of authorship.

¹³¹ *Id.* at 1176-77.

¹³² 17 U.S.C. § 107(4) (1988).

¹³³ *Acuff-Rose*, 114 S. Ct. at 1177.

¹³⁴ *Id.* at 1179.

¹³⁵ *Id.* at 1177-79.

¹³⁶ *Id.* at 1177.

¹³⁷ *Id.* at 1171-73.

¹³⁸ "As future courts apply our fair use analysis, they must take care to ensure that not just any commercial take-off is rationalized *post hoc* as a parody." *Id.* at 1182 (Kennedy, J., concurring).

B. *The Right of Publicity's Treatment of First Amendment Concerns*

Consistent with the above copyright cases, the First Amendment has been given little attention in right of publicity analysis, but not because of any self-imposed limitations like the idea/expression doctrine or fair use exception. Rather, courts have fallen back on logic similar to *Zacchini's*: the person is not seeking to withhold appropriation; she is merely seeking to be compensated for its use.¹³⁹ The other major block towards recognizing a First Amendment defense in these cases has been the slight protection granted commercial speech. As shown in *White*, the finding of any amount of commercial motivation is virtually the kiss of death to a First Amendment defense, even one based on an intent to parody the original.¹⁴⁰ Even in the exalted field of news reporting, it is difficult to conceive of a pure appropriation of publicity, untainted by commercial avarice.¹⁴¹ Still, as *Midler* indicates, the courts are willing to see this "newsworthiness" as an exception to an individual's right of publicity.¹⁴² Thus, the First Amendment provides only a limited amount of control over the right of publicity and—given the breadth of the *White* opinion—a way must be found to rein in the right of publicity. The following segment proposes a solution to this problem.

¹³⁹ *Zacchini v. Scripps-Howard Broadcasting, Co.*, 433 U.S. 562, 578 (1977). "Petitioner does not seek to enjoin the broadcast of his performance; he simply wants to be paid for it."

¹⁴⁰ *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395, 1401 (9th Cir. 1992) ("The difference between a 'parody' and a 'knock-off' is the difference between fun and profit."), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

¹⁴¹ Consider, for instance, network rating wars and the recent explosion of tabloid journalism; what passes for news in the modern world is just as keyed to the commercial market as Samsung's ad campaign.

¹⁴² "The purpose of the media's use of a person's identity is central. If the purpose is 'informative or cultural' the use is immune; 'if it serves no such function but merely exploits the individual portrayed, immunity will not be granted.'" *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988) (quoting *Felcher & Rubin*, *supra* note 44, at 1596).

V. OPTIONS AVAILABLE TO MODIFY THE RIGHT OF PUBLICITY

A. *Arguments for the Complete Destruction of the Right of Publicity*

One commentator argues a drastic position: the complete abolition of the right of publicity.¹⁴³ However, the right of publicity serves a useful function in today's law and should not be so lightly discarded. The right of publicity has grown to fill a gap in the federal copyright scheme, providing protection for those works which do not qualify for copyright protection because they are unfixed.¹⁴⁴ Goldman, in recommending the end of this right, sees copyright law and defamation suits as providing adequate protection for publicity rights, thereby belittling the unjust enrichment and personal autonomy rationales of the right of publicity.¹⁴⁵

As part of his argument that the right of publicity is useless in light of existing law, however, Goldman suggests that the First Amendment permits most exploitation of celebrity appropriation to go unchecked, even that which is employed in the commercial context.¹⁴⁶ Unless courts start applying the *Central Hudson*¹⁴⁷ test for protected commercial speech to cases like *White*, commercial speech will not be so protected; thus, the right of publicity is of significant importance to the commercial speech debate. In its role of providing protection to works outside of copyright or trademark, the right of publicity serves an important role in our modern legal system: it prevents unjust enrichment at the expense of the celebrity.

¹⁴³ Goldman, *supra* note 13, at 625-28.

¹⁴⁴ Fixation is a requirement for copyright protection. 17 U.S.C. § 102(a) (1988). It means that the author's work has assumed tangible form, and is able "to be perceived." 17 U.S.C. § 101. An example of such work is the protection of Bette Midler's voice in *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988). Had the defendant actually played a recording of the song, then copyright's statutory protection would have been triggered. By using the sound alike, however, the defendant nearly found a loophole, which was tied off by the right of publicity.

¹⁴⁵ Goldman, *supra* note 13, at 605-07.

¹⁴⁶ "Admittedly, a celebrity may feel frustrated if his name or likeness is used to further sales of a product or service . . . [H]owever, most such uses of a celebrity's identity would have an expressive element worthy of First Amendment protection." *Id.* at 607.

¹⁴⁷ See *supra* text accompanying notes 79-84.

B. *Reforming the Right of Publicity*

If the right of publicity is to remain a useful part of the modern legal system, it must be narrowed and modified. A primary area needing reform is the right of publicity's interface with the First Amendment. To best modify this area, courts would do well to bring the scope of the right of publicity closer to that of its neighbor—copyright.

1. *Engrafting Copyright's First Amendment Safeguards onto the Right of Publicity*

a. *Integrating the Idea/Expression Doctrine into the Right of Publicity Analysis*

The right of publicity would benefit from the addition of an idea/expression component. The effect of adopting the idea/expression doctrine into the right of publicity analysis would be to allow protection of a person's particular expression of an idea, but not the idea itself. Such a limitation of the right of publicity would prevent the logical conclusion of *White*'s majority opinion, best articulated in Judge Alarcon's thoughtful dissent:

The majority's position seems to allow any famous person or entity to bring suit based on any commercial advertisement that depicts a character or role performed by the plaintiff. Under the majority's view of the law, Gene Autry could have brought an action for damages against all other singing cowboys. Clint Eastwood would be able to sue anyone who plays a tall, soft-spoken cowboy, unless, of course, Jimmy Stewart had not previously enjoined Clint Eastwood.¹⁴⁸

If the idea/expression dichotomy had been used in *White*, finding for the plaintiff would have been extremely difficult given the elements that the

¹⁴⁸ *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395, 1407 (9th Cir. 1992) (Alarcon, J., dissenting), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993). Copyright law has dealt with a similar issue, holding that characters themselves are not copyrightable—only the entire work is protectable. *Warner Bros. v. American Broadcasting Co.*, 720 F.2d 231 (2d Cir. 1983) (holding that the "Greatest American Hero" did not infringe "Superman"); *Detective Comics v. Bruns Publications*, 111 F.2d 432 (2d Cir. 1940) (holding that defendant's "Wonderman" was an infringement on "Superman").

defendant mimicked; Ms. White can hardly have earned a monopoly on the portrayal of a glamorous game show hostess.

b. *Employing Copyright's Fair Use Doctrine in Right of Publicity Analysis*

Applying a fair use analysis to right of publicity cases would involve the assimilation of *Maxtone-Graham*'s four element interpretation of copyright's fair use test. In a right of publicity case, the trier of fact would first examine the nature of the use (*i.e.*, whether it was commercial or non-profit); second, determine the nature of the publicity right; third, assess the amount taken from the original; fourth, calculate the appropriation's effect on the market.¹⁴⁹ In analyzing right of publicity claims in this manner, a court would have to be careful to acknowledge the *Central Hudson* concerns regarding protected commercial speech. This acknowledgement would be necessary because an appropriation not constituting a fair use of the original would then deserve examination under the First Amendment.¹⁵⁰ As per the *Acuff-Rose* decision, a finding of a commercial use must not be allowed to dictate a finding against the defendant in right of publicity cases. All four elements must be examined individually, even if the defendant had used the original for commercial gain.

Had *White* been analyzed under a fair use defense, it is likely that the decision would have still been for the plaintiff, because of the emphasis courts have placed on the commercial elements of the *Maxtone-Graham* test.¹⁵¹ It remains to be seen, however, if courts will continue this trend in light of the *Acuff-Rose* decision. Under the first element—nature of use—a court could not help but find for the plaintiff; advertising is indisputably a commercial use. As *Maxtone-Graham* indicated, however, the commercial use should not be fatal to the fair use claim, but merely should be considered as a way to evaluate harm done to the plaintiff.¹⁵² Because of the *Acuff-Rose* decision, a court could not consider this element to be dispositive of the case; all four elements would have to be weighed.

In regard to the nature of the publicity right, the plaintiff's position in *White* indicates that appearance was the publicity right in issue. On this second element of the fair use test, the plaintiff would have been hard pressed to argue that her manner of dress was a unique possession of

¹⁴⁹ See *Maxtone-Graham v. Burtchaell*, 803 F.2d 1253, 1260–64 (2d Cir. 1986) and Samuelson, *supra* note 108, at 886; see also text accompanying notes 97–103.

¹⁵⁰ See *supra* text accompanying notes 79–84.

¹⁵¹ See *supra* text accompanying notes 97–103.

¹⁵² *Maxtone-Graham*, 803 F.2d at 1261–62.

hers—glamorous dress being available to all who can afford it.¹⁵³ Judge Kozinski's dissent addressed this point and observed that what truly evokes Ms. White's image in the ad is not solely the robot's mimicry of her appearance, but that "the robot is posed near the 'Wheel of Fortune' game board."¹⁵⁴ In his view, it was the use of the set and not the robot's appearance that called her right of publicity into question. Using this logic, the nature of the right here is the appearance of the whole "Wheel of Fortune" set. Since Ms. White is not the promoter of the entire set, her right of publicity was not compromised. If the nature of the publicity right in question had been so argued, the defendant might well have prevailed on this element of the fair use test.

On the third element, all that the defendant took was a generic appearance to which the plaintiff laid claim. As indicated in the analysis of the second element—the nature of the publicity right in question—the situation would be much different if Ms. White could enforce the rights of the entire set. However, since the plaintiff is limited to enforcing only her right of publicity, only the resemblance of the robot could have been considered. In this narrow area, the only similarities were manner of dress, hairstyle, and pose.¹⁵⁵ With only these similarities to consider, it is highly likely that the defendant would have prevailed on this element of the fair use test.

Finally, the effect on the market requires much more evidence than that which was contained in the factual record. All that can be said for certain is that Ms. White missed out on whatever Samsung might have paid her for its appropriation of her identity. When all foregoing elements are weighed, this defendant might well have established a fair use, but only if the court avoided the conclusion that a commercial use was by definition fatal to a fair use claim. The *Acuff-Rose* decision sends a cautionary message to courts that have overemphasized the commercial aspect in fair use analysis. It remains to be seen, however, how courts will integrate *Acuff-Rose* into their fair use cases.¹⁵⁶

¹⁵³ "[T]here must be ten million blond women (many of them quasi-famous) who wear dresses and jewelry like White's." *White v. Samsung Electronics America, Inc.*, 989 F.2d 1512, 1515 (9th Cir.) (Kozinski, J., dissenting), *cert. denied*, 113 S. Ct. 2443 (1993).

¹⁵⁴ *Id.*

¹⁵⁵ *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395, 1396 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 113 S. Ct. 2443 (1993).

¹⁵⁶ While the language of *Acuff-Rose* strongly urges courts to avoid focusing on commercial aspects, these factors will be difficult for judges to ignore. *Acuff-Rose* does not give trial judges any firm rules to apply in their analyses, and thus this author fears that future judges will take care to avoid emphasizing the commercial elements,

2. Encouraging a More Active Role for the First Amendment in Both Copyright and Right of Publicity Defenses

Engrafting copyright's protections of First Amendment rights onto the right of publicity would greatly improve the reasonableness of this property right. What remains, however, is the low level of consideration that the First Amendment receives as a defense in both copyright and right of publicity litigation. The Supreme Court's decision in *Campbell v. Acuff-Rose Music, Inc.*¹⁵⁷ does little to articulate the First Amendment's value in this area. However, *Acuff-Rose* does establish that parodies can receive copyright's fair use protections. As seen in Judge Kozinski's dissent to *White*, parody serves an important public purpose analogous to the speech which the First Amendment certainly protects—political discourse and the like.¹⁵⁸ The form parody takes is certainly different from that of protest language, but “[p]arody, humor, [and] irreverence are all vital components of the marketplace of ideas.”¹⁵⁹ *Acuff-Rose* clarifies the position of parody in the copyright realm and shows that First Amendment concerns can be addressed through fair use analysis. The right of publicity would do well to emulate this result.

VI. SUMMARY

When a new legal right is created, growth in response to changing social needs is inevitable and even laudable. It is that growth which makes law responsive and flexible. Under the courts' tutelage, however, a new legal right must be carefully shaped so that its form does not flow beyond its limited purpose and encroach adversely upon other areas of the law. Thus far, court attention to the right of publicity has only broadened its scope. Before its process of growth continues—and makes protecting any rights of publicity absurd—the courts would do well to limit the scope of the right of publicity and temper it in a direction more amenable to the First Amendment. Rather than invent an entirely new and different scheme for the purpose of this limitation, the existing copyright law doctrines of idea/expression and fair use can be easily adapted for use in the right of

but will allow the commercial aspects to silently influence their analyses of the fair use elements.

¹⁵⁷ 754 F. Supp. 1150 (M.D. Tenn. 1991), 972 F.2d 1429 (6th Cir. 1992), *rev'd*, 114 S. Ct. 1164 (1994).

¹⁵⁸ *White*, 989 F.2d at 1519 (Kozinski, J., dissenting).

¹⁵⁹ *Id.*

publicity analysis. Given the Court's *Acuff-Rose* ruling, greater protection of parody is now possible, allowing copyright law to intermesh better with the First Amendment. Proponents of the right of publicity would do well to emulate such a result, lest the argument for the right of publicity's abolition gain strength and popularity.

Bestowing any sort of property right is not without cost, and the right of publicity is no exception. Inevitably, there must be some encroachment on the First Amendment, but this encroachment can be made mild in effect. Under the above proposal, the right of publicity would no longer diminish so severely First Amendment rights of free expression.